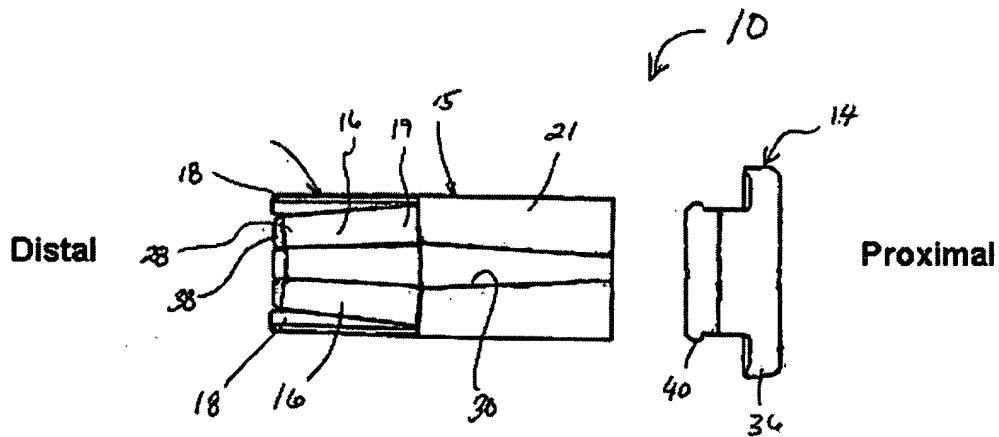


**REMARKS**

Claims 1 and 3 have been amended. Claims 5-14 have been added.

**APPLICANTS' INVENTION**

Applicants' invention relates to an adapter by which an endoscope accessory can be attached to endoscopes of different diameters. The adapter avoids the necessity of maintaining an inventory of accessories with various diameters to fit a variety of specific diameter endoscopes. The adapter 10 includes two components, a centering sleeve 15 mountable in the central bore of the accessory that otherwise would receive the endoscope directly, and a collar 14 engageable with the proximal end of the accessory. The collar 14 supports the proximal end of the accessory and the centering sleeve 15 supports and positions the distal end of the accessory with respect to the endoscope. In the illustrative embodiment, the centering sleeve 15 may include two sets of distally projecting fingers 16, 18. The ends of the fingers 18 abut a distal lip on the accessory to fix the position of the accessory on the adapter. The other fingers 16 taper inwardly to a diameter sufficient to engage the cylindrical outer surface of the distal portion of the endoscope. Fingers 16 are radially expandable to accommodate endoscopes of different diameters. A plurality of collars 14 may be provided in a kit, each being adapted to receive a limited range of endoscope diameters. The fingers 16 are radially expandable to correspond to the range of endoscopes receivable by all of the collars in the kit.



## **THE CITED ART**

### **U.S. Patent No. 6,306,081 (Ishikawa)**

Ishikawa discloses an endoscopic accessory in the form of a hood that mounts directly to the distal end of an endoscope. The hood can be extended distally beyond the end of the endoscope when the observation space and operating field is narrow, such as in the esophagus, or, when a broader observation field exists, such as in the stomach, the extended hood can be retracted so as not to interfere with the observation space and operation field. The hood is in the form of an inflatable and deflatable balloon that is mounted to a two-piece body member 5 that includes a joining member 4 and a mount member 3 that are bonded to each other. (2:53-56). The body member 5 is attached to the endoscope by “...the mount member 3 [which] is intimately joined, adhesively bonded or threaded, for example, to the outer peripheral surface of the distal end portion 2 of the endoscope.” (2:50-53). Thus, joining member 4 and mount member 3 comprise an integral, unitary body member 5 that supports the balloon and is “intimately joined” as by adhesive or threads directly to the endoscope.

### **Claim Rejections**

Reconsideration is requested of the rejection of claims 1 and 2 as anticipated by Ishikawa under 35 U.S.C. §102(b). Ishikawa does not disclose an adapter for mounting an accessory on the distal end of an endoscope. Ishikawa discloses no more than the accessory itself which is intended to be mounted directly to the endoscope, as by adhesive or by threading the accessory directly to the endoscope. There is no adapter by which an endoscope accessory may be mounted to endoscopes of different diameters. The endoscopic accessory disclosed in Ishikawa relates to an extendable and retractable hood that is mounted by a “body 5” directly to the endoscope. The body is either bonded or threaded to the endoscope and provides no means or suggestion by which it may be attached to endoscopes of different diameters. Ishikawa presents precisely the problem in the prior art for which applicants’ invention provides a solution. To the extent that the rejection is based on the notion that the inflatable balloon in Ishikawa corresponds to applicants’ claimed radially expandable elements, that misreads the claim and applicants’ disclosure. The Ishikawa balloon is inflated to extend the “hood” and is deflated to retract the

hood. The radially expandable elements in applicants' invention provide the means by which the sleeve can self-accommodate to a range of endoscope diameters.

Reconsideration also is requested of the rejection of claims 3 and 4 on the grounds of obviousness in view of Ishikawa, alone. In order for a single prior art reference to render the claimed invention obvious, there must be a sufficient showing of a suggestion or motivation for any modification of the teachings of that reference necessary to reach the claimed invention in order to support the obviousness conclusion. *Sibia Neuroscis., Inc. v. Cadus Pharm. Corp.*, 225 F.3d 1349, 1356, 55 USPQ2d 1927, 1931 (Fed. Cir. 2000); *B.F. Goodrich Co. v. Aircraft Braking Sys. Corp.*, 72 F.3d 1577, 1582, 37 USPQ2d 1314, 1318 (Fed. Cir. 1996). This suggestion or motivation may be derived from the prior art reference itself, from the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. *Sibia*, 225 F.3d at 1356, 55 USPQ2d at 1931. *McGinley v. Franklin Sports, Inc.* 262 F.3d 1339, 60 USPQ2d 1001 (Fed. Cir. 2001).

The obviousness rejection of claims 3 and 4 is based solely on Ishikawa, and the action presents no additional evidence as to why one of ordinary skill would have been motivated to modify Ishikawa in accordance with applicants' invention. In the absence of such evidence, the rejection of claims 3 and 4 under 35 U.S.C. §103(a) is improper and should be withdrawn.

Each of new claims 5-14 depends directly or indirectly from one of claims 1-4 and are not properly rejectable in view of Ishikawa.

Respectfully submitted,



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